

REMARKS

Claims 1-42 and 45-60 are currently pending in the application, with claims 1, 17, 18, 26, 42, 45, and 53 being independent. New claim 61 is presented for consideration by the Examiner. Applicants respectfully request favorable consideration of this response in light of the amendments and comments contained herein, and earnestly seek timely allowance of the pending claims.

In the outstanding Official Action, the Examiner rejected claims 1-60 under 35 U.S.C. §112, second paragraph. The Examiner further rejected claims 1-9, 12, 18-24, 26-34, 36 and 42 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,515,491 to *Bates* ("*Bates*"); and rejected claims 10-11, 13-17, 25, 35, 37-41, 45-60 under 35 U.S.C. 103(a) as being unpatentable over *Bates* in view of U.S. Patent No. 6,502,756 to *Sekendur* ("*Sekendur*"). Applicants respectfully traverse these rejections.

Preliminary Comments

On June 2, 2006, Applicant representatives Catherine Voisinnet and John Voisinnet conducted a personal interview with the Examiner to discuss the §112 rejection of claims 45 and 53, the §102 rejection of claim 1, and §103 rejections of claims 45 and 53, as set forth in the outstanding Office Action. While the Examiner did concede during the interview that he understood this feature after consideration of the specification, he felt that the issue would require further consideration and consultation with a Quality Assurance Specialist (QAS). However, in the outstanding Official Action, the Examiner failed to advise Applicants of the result of the consultation with the QAS. Applicants respectfully request the Examiner provide Applicants with the results of the consultation with the QAS.

In addition, on May 24, 2006, Applicants filed an Information Disclosure Statement requesting consideration of one cited document. To date, Applicants have not received notification of consideration of this cited document by the Examiner. Applicants respectfully request consideration of the document cited in the Information Disclosure Statement properly filed May 24, 2006.

Claims Rejections Under 35 U.S.C. §112

In Applicants' Reply filed June 15, 2006, Applicants argued that the term "practicable useable surface" is definite. In response to this argument, the Examiner merely responds by asserting "the specification does relate the terms "practicable" and "useful" to any range or for any purpose and therefore indefinite." In addition, during the Interview conducted on June 2, 2006, the Examiner conceded that he understood this claim term after consideration of the specification.

The second paragraph of 35 U.S.C. §112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

As the Examiner admits that the specification provides sufficient evidence to one skilled in the art so as to set out and circumscribe a particular area with a reasonable degree of precision and particularity, both in the outstanding Official Action and in the Personal Examiner Interview, Applicants respectfully maintain that this claim term is definite. It is respectfully requested that the outstanding rejection be withdrawn.

Claims Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1-9, 12, 18-24, 26-34, 36 and 42 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,515,491 to *Bates* ("*Bates*"). Applicant submits the Examiner has failed to establish a *prima facie* case of anticipation and respectfully traverses the rejection.

In Applicants' previously filed Reply, Applicants argued that *Bates* fails to disclose, at least, "wherein the imaginary surface represents physical positions in a unique and continuous manner, and represents a physical area which is larger than any single practicable usable surface," as recited in claims 1, 17, 18, 26, and 42.

Bates is distinguished by the present invention in that the coordinates represented are purely virtual, and do not represent physical positions in unique and continuous manner. Moreover, the virtual coordinates disclosed by *Bates* cannot represent a surface which is larger than any single practical useable surface.

In response to this argument, the Examiner merely responds by asserting that the surface of *Bates* is virtual and can represent any physical area, wherein each virtual pixel can represent a square inch, a square mile, or any physical area. However, these teachings are insufficient to anticipate representing a physical area which is larger than any single practicable useable surface. Even if the Examiner's assertions were true, although it is possible for *Bates* to have a virtual surface that represents a physical area, anticipation may not be established by probabilities or possibilities. See *Continental Can Co. USA v. Monsanto*, 20 USPQ.2d 1746, 1749, 1750 (Fed. Cir. 1991). There is no teaching or suggestion in *Bates* that is directed to the imaginary surface representing physical positions in a unique and continuous manner and represents a physical area which is larger than any single practicable usable surface. As such, Applicants maintain that the Examiner has failed to establish *prima facie* anticipation.

Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 1, 17, 18, 26, and 42. Claims 2-16 depend from claim 1 and are allowable at least by virtue of their dependency from allowable claim 1. Claims 19-25 depend from claim 18 and are allowable at least by virtue of their dependency from allowable claim 18. Claims 27-41 depend from claim 26 and are allowable at least by virtue of their dependency from allowable claim 26.

Claims Rejections Under 35 U.S.C. §103

The Examiner rejected claims 10-11, 13-17, 25, 35, 37-41, 45-60 under 35 U.S.C. 103(a) as being unpatentable over *Bates* in view of U.S. Patent No. 6,502,756 to *Sekendur* ("*Sekendur*"). Applicant submits the Examiner has failed to establish of *prima facie* case of obviousness and respectfully traverses the rejection.

At the outset, Applicants respectfully submit that U.S. Patent No. 6,502,756 is issued to Fahraeus, not *Sekendur*. Applicants attempted to provide a guess, in the form of a patent number,

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to the Examiner as to what reference the Examiner was relying upon in his rejection. However, the Examiner failed to consider Applicants comments and, further, has failed to correctly identify the reference the Examiner is relying upon in support of his rejection.

Applicants respectfully submit that U.S. Patent No. 6,502,756 is not prior art with respect to the present application. At least for this reason, the outstanding rejection should be withdrawn.

If the Examiner is relying upon a patent that is issued to *Sekendur*, Applicants cannot properly identify the art that is being cited against the pending claims. As such, Applicants do not have a proper opportunity to respond.

Should the Examiner cite a new reference, that may or may not be issued to *Sekendur*, Applicants respectfully request the Examiner do so in a new, non-final Official Action.

Further, in Applicants' previously filed Reply, Applicants argued that nowhere does *Bates* teach that the window is larger than any single surface as asserted by the Examiner. Applicants argued that *Bates* shows screen coordinates which have a one-to-one mapping with individual memory locations in video memory, and would be limited by the size of the display screen and the size of the memory on the video card driving the display. However, the Examiner has failed to consider Applicants' argument.

Further, Applicants argued that neither *Bates* or *Sekendur* teach or suggest, at least, "wherein the imaginary surface represents physical positions in a unique and continuous manner, and represents a physical area which is larger than any single practicable usable surface," as recited in claim 17; and "wherein the two-dimensional coordinate reference represents physical positions in a unique and continuous manner, and represents a physical area which is larger than any single practicable usable surface," as recited in claims 45 and 53.

Applicants noted that it appears the above feature, "larger than any single practicable surface," did not appear to be considered in the rejection. While this feature was at issue in the 112 rejection, Applicant submits that the Examiner must accord this feature patentable weight consider it in the analysis of the rejection.

However, the Examiner has failed to consider any of these arguments.

Still further, Applicants argued that because *Bates* already discloses utilizing a light pen as a user interface, and because *Bates* teaches a virtual system which keeps records regarding users digitally, there would be no motivation to modify *Bates* by the teachings of *Sekendur*. Utilizing *Sekendur*'s paper system would be antithetical to computer collaboration system and would increase the cost of operating the system.

However, the Examiner has failed to consider this argument.

Applicants direct the Examiner's attention to Applicants' previously filed reply for the details of the arguments set forth herein. Should the Examiner maintain his rejection of the claims, Applicants respectfully request the Examiner do so by withdrawing the finality of the outstanding Official Action, and issuing a new Official Action properly 1) identifying the proper prior art so that Applicants can read and understand the outstanding rejection; and 2) properly considering all of Applicants' arguments set forth herein, as more fully set forth in Applicants' previously filed Reply.

For all of the reasons set forth above, Applicants respectfully submit that the Examiner has failed to establish prima facie obviousness. Applicants respectfully request the Examiner withdraw the rejection of claims 17, 45, and 53. Claims 46-52 depend from claim 45 and are allowable at least by virtue of their dependency from allowable claim 45. Claims 54-60 depend from claim 53 and are allowable at least by virtue of their dependency from allowable claim 53.

CONCLUSION

In view of the above remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinnet (Reg. No. 52,327) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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